

REMARKS/ARGUMENTS

Responsive to the Office Action dated August 21, 2007, Applicants have filed this Amendment. Claims 1 - 20 are pending for prosecution. Claims 1, 8, and 15 are independent.

I. Claim Rejections under 35 U.S.C. § 112

Claims 1-14 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Examiner objects to the recitation of “may” or “may be” in the claims and suggests removal of same. Claims 1 and 8 have been amended in accordance with the Examiner’s suggestion. Accordingly, Applicants respectfully request withdrawal of this rejection.

II. Claim Rejections Under 35 U.S.C. § 103

Claims 1 - 20 stand 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,978,248 to Walker et al. For at least the following reasons, Applicants respectfully request reconsideration and withdrawal of this rejection.

When determining the question of obviousness, underlying factual questions are presented which include (1) the scope and content of the prior art; (2) the level of ordinary skill in the art at the time of the invention; (3) objective evidence of nonobviousness; and (4) the differences between the prior art and the claimed subject matter. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). Moreover, with regard to the last prong of the *Graham* inquiry, “[t]o determine whether there was an apparent reason to combine the known

elements in the way a patent claims, it will often be necessary to look to interrelated teachings of multiple patents; to the effects of demands known to the design community or present in the marketplace; and to the background knowledge possessed by a person having ordinary skill in the art. To facilitate review, this analysis should be made explicit.” KSR International v. Teleflex Inc., 127 U.S. 1727 (2007).

The person of ordinary skill in the art is a hypothetical person who is presumed to know the relevant prior art. Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc., 807 F.2d 955, 962, 1 USPQ2d 1196, 1201 (Fed. Cir. 1986). **The level of ordinary skill in the art of providing search results can be determined by looking to the references of record.** In re GPAC, Inc., 57 F.3d 1573, 35 USPQ2d 1116 (Fed. Cir. 1995). The references of record in this case reveal that a moderate level of sophistication is present in the area of providing search results. Thus, Applicant submits that, as substantiated by the cited references, those with some experience in providing search results, including a well funded search technology companies, or the like would most likely be a person with ordinary skill in the this field of endeavor.

With respect to objective evidence of nonobviousness, Applicants submit that the record supports the conclusion that there are long-felt but unsolved needs met by the present invention. For at least this reason, Applicants respectfully submit that the claimed invention is NOT obvious in view of the cited references.

Finally, prima facie obviousness requires that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references. This motivation-suggestion-teaching test informs the Graham analysis. “To reach a non-hindsight driven conclusion as to whether a person having ordinary skill in the art at the time of the invention would have viewed the subject

matter as a whole to have been obvious in view of multiple references,” there must be “some rationale, articulation, or reasoned basis to explain why the conclusion of obviousness is correct.” *In re Kahn*, (Fed. Cir. 2006). The recent *KSR International* decision by the Supreme Court has not eliminated the motivation-suggestion-teaching test to determine whether prior art references have been properly combined. Rather, in addition to the motivation-suggestion-teaching test, the Court discussed that combinations of known technology that are “expected” may not be patentable. Stated in the affirmative, therefore, combinations are nonobvious and patentable if unexpected. In the present application, no single prior art reference nor any combination thereof (legitimate or otherwise) meets the claimed limitations of Applicants’ invention.

Applicants respectfully disagree with the assertion set forth on page 4 of the Office Action, that col. 11, lines 37-55 of the Walker reference teach, suggest, or disclose the step of “evaluating feedback as to the effectiveness of each test message.” The cited portion of the Walker reference is not directed to evaluation of feedback of a test message. Instead, the cited portion discloses “a flowchart of a method of analyzing the results of the e-mail test and ***selecting the most effective postal mailing list to use*** in accordance with an embodiment of the present invention.” [emphasis added].

Additionally the Walker reference fails to disclose, teach, or suggest the step of “creating a final message based on the evaluation of the feedback” as recited by claim 1. The Office Action is silent as to this recited element entirely.

Finally, Applicants agree with the Examiner’s assertion set forth on page 4 of the Office Action that Walker “... does not explicitly teach employing different group of users for receiving the test message and different group of users who would receive the final message.”

Thus, the above quoted Examiner's assertion, combined with the Walker reference's complete omission of the steps of "evaluating feedback as to the effectiveness of each test message" and "creating a final message based on the evaluation of the feedback" cannot render claim 1 obvious. For at least the aforementioned reasons, Applicants respectfully request allowance of claim 1. Claims 2-6 depend from claim 1 and are allowable for at least the same reasons. Additionally, according to page 5 of the Office Action, "[c]laims 8-20 are similar in scope as that of claims 1-7." Accordingly, applicants request allowance of claims 8-20 for at least the same reasons.

Conclusion

Applicants respectfully submit the claims are in condition for formal allowance which is courteously solicited. If any issue regarding the allowability of any of the pending claims in the present application could be readily resolved, or if other action could be taken to further advance this application such as an Examiner's amendment, or if the Examiner should have any questions regarding the present amendment, it is respectfully requested that the Examiner please telephone Applicant's undersigned attorney in this regard. Should any fees be necessitated by this response, the Commissioner is hereby authorized to deduct such fees from Deposit Account No. 11-0160.

Respectfully submitted,

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